

## REMARKS

Claims 1, 3-12, 14-23, and 25-32 were previously pending in this patent application. Claims 1, 3-12, 14-23, and 25-32 stand rejected. Herein, Claims 1, 12, and 23 have been amended. Accordingly, after this Amendment and Response, Claims 1, 3-12, 14-23, and 25-32 remain pending in this patent application. Further examination and reconsideration in view of the claims, remarks and arguments set forth below is respectfully requested.

### Claim Objections

Claims 1, 3-12, 14-23, and 25-32 stand objected to as failing to comply with the written description requirement. The use of the terms "a body" and "said body of" in the Independent Claims 1, 12, and 23 prompted these claim objections. Herein, Independent Claims 1, 12, and 23 have been amended to remove the terms "a body" and "said body of". Therefore, withdrawal of the claim objections is respectfully requested.

### 35 U.S.C. Section 103(a) Rejections

Claims 1, 3, 5-12, 14, 16-23, 25, and 27-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mamiya et al., U.S. Patent No. 5,764,322 (hereafter Mamiya), in view of Kubo et al., U.S. Patent No. 6,456,279 (hereafter Kubo). These rejections are respectfully traversed.

Independent Claim 1 recites (as amended):

A display assembly for an electronic device comprising:  
a backlight device;  
a reflective display disposed above said backlight device and comprising a top surface and a bottom surface;  
an **embedded light guide which is embedded in said reflective display** between said top surface and said bottom surface wherein said embedded light guide is for conducting light from said backlight device to an area in front of said top surface of said reflective display, wherein said **embedded light guide is disposed above said backlight device**; and  
a front light reflecting film disposed above said top surface of said reflective display. (emphasis added)

To establish a *prima facie* case of obviousness pursuant to 35 U.S.C. 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

It is respectfully asserted that there is no teaching, suggestion, or motivation to modify or combine Mamiya and Kubo and that there is no reasonable expectation of success if Mamiya and Kubo are modified or combined. More importantly, the modified or combined references Mamiya and Kubo fail to teach, suggest, or motivate all the claim limitations of Independent Claim 1.

Independent Claim 1 recites the limitation, "***an embedded light guide which is embedded in said reflective display...*** wherein said ***embedded light guide is disposed above said backlight device,***" (emphasis added). At page 4 of the Office Action, it is admitted that Mamiya does not describe an embedded light guide, as in the invention of Independent Claim 1. Further, Figures 4 and 11 of Kubo and various passages of Kubo are cited as describing an embedded light guide which is embedded in the reflective display.

It is argued in the Office Action at page 4 that element 2 of Figure 4 and elements 1E-1K of Figure 11 in Kubo correspond to the embedded light guide of Independent Claim 1. While Figure 4 shows element 2 disposed at the same level as the light device labeled as element 3, the embedded light guide of Independent Claim 1 is disposed above the backlight device. Additionally, Figure 11 illustrates elements 1E-1K disposed below the light source labeled as element 3A, but the embedded light guide of Independent Claim 1 is disposed above the backlight device.

As discussed in detail above, the modified or combined references Mamiya and Kubo fail to teach, suggest, or motivate all the claim limitations of Independent Claim 1. Therefore, it is respectfully submitted that Independent Claim 1 is patentable over the modified or combined references Mamiya and Kubo and is in condition for allowance.

Dependent Claims 3 and 5-11 are dependent on allowable Independent Claim 1, which is allowable over the modified or combined references Mamiya and Kubo. Hence, it is respectfully submitted that Dependent Claims 3 and 5-11 are patentable over the modified or combined references Mamiya and Kubo for the reasons discussed above.

With respect to Independent Claims 12 and 23, it is respectfully submitted that Independent Claims 12 and 23 recite similar limitations as in Independent Claim 1. In particular, Independent Claims 12 recites the limitation, "a reflective display disposed above said backlight device and comprising a top surface, a bottom surface, and ***an embedded light guide which is embedded in said reflective...*** wherein said ***embedded light guide is disposed above said backlight device,***" (emphasis added). Independent Claims 23 recites the limitation, "a plurality of ***embedded light guides which are embedded in said reflective display...*** wherein said ***embedded light guides are disposed above said backlight device,***" (emphasis added). As discussed above, the modified or combined references Mamiya and Kubo fails to teach, suggest, or motivate the cited limitations. Therefore, Independent Claims 12 and 23 are allowable over the modified or combined references Mamiya and Kubo for reasons discussed in connection with Independent Claim 1.

Dependent Claims 14, 16-22 and Dependent Claims 25, 27-32 are dependent on allowable Independent Claims 12 and 23, respectively, which are allowable over the modified or combined references Mamiya and Kubo. Hence,

it is respectfully submitted that Dependent Claims 14, 16-22, 25, and 27-32 are patentable over the modified or combined references Mamiya and Kubo for the reasons discussed above.

At page 6 of the Office Action, it is stated that Claims 7, 8, 9, 18, 19, 20, 29, 30, and 31 recite limitations directed to the manner in which the claimed apparatus is intended to be employed, citing the court decision EX PARTE MASHAM, 2 USPQ 2d 1647 (1987). More specifically, it is argued, "limitations the reflective display is used as a electronic ink display and electronic paper display," (emphasis added), are directed to the manner in which the claimed apparatus is intended to be employed.

However, the term "used" is not found in the Claims 7, 8, 9, 18, 19, 20, 29, 30, and 31. Moreover, Claims 7, 8, 9, 18, 19, 20, 29, 30, and 31 have a limitation format similar to the limitation format of Claims 3, 5, 14, 16, 25, and 27, which were not identified as being directed to the manner in which the claimed apparatus is intended to be employed. Further, the limitation "completely submerged in the developer material" was found to relate to the intended manner of employing the claimed apparatus in the court decision EX PARTE MASHAM. Unlike the limitation in EX PARTE MASHAM, Claims 7, 8, 9, 18, 19, 20, 29, 30, and 31 have the terms "is" or "comprises" to claim specific embodiments rather than claim the manner in which the claimed apparatus is intended to be employed. Therefore, Claims 7, 8, 9, 18, 19, 20, 29, 30, and 31

are patentable over the modified or combined references Mamiya and Kubo for these additional reasons. Attached hereto is the EX PARTE MASHAM court decision.

Claims 4, 15, and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mamiya et al., U.S. Patent No. 5,764,322 (hereafter Mamiya), in view of Kubo et al., U.S. Patent No. 6,456,279 (hereafter Kubo), and in view of Hirakata et al., U.S. Patent No. 6,191,833 (hereafter Hirakata). These rejections are respectfully traversed.

Dependent Claim 4, Dependent Claim 15, and Dependent Claim 26 are dependent on allowable Independent Claims 1, 12, and 23, respectively, which are allowable over the modified or combined references Mamiya and Kubo. Moreover, Hirakata does not teach, motivate, or suggest embedded light guide(s) which is embedded in the reflective display and does not teach, motivate, or suggest the embedded light guide(s) is disposed above the backlight device, as in the invention of Independent Claims 1, 12, and 23. Hence, it is respectfully submitted that Independent Claims 1, 12, and 23 are patentable over the modified or combined references Mamiya, Kubo, and Hirakata for the reasons discussed above. Since Dependent Claims 4, 15, and 26 depend from Independent Claims 1, 12, and 23, respectively, it is respectfully submitted that Dependent Claims 4, 15, and 26 are patentable over the modified or combined references Mamiya, Kubo, and Hirakata for the reasons discussed above.

### CONCLUSION

It is respectfully submitted that the above claims, remarks, and arguments overcome all rejections and objections. All remaining claims (Claims 1, 3-12, 14-23, and 25-32) are neither anticipated nor obvious in view of the cited references. For at least the above-presented reasons, it is respectfully submitted that all remaining claims (Claims 1, 3-12, 14-23, and 25-32) are in condition for allowance.

The Examiner is urged to contact Applicant's undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 50-4160.

Respectfully submitted,

MURABITO HAO & BARNES, LLP

Dated: \_\_\_\_\_

4/20/2007

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Attachment: EX PARTE MASHAM, 2 USPQ 2d 1647 (1987), court decision

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## **BPAI**

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\*1 EX PARTE ROGER D. MASHAM

Appeal No. 671-94

February 26, 1987

Application for Patent filed May 24, 1984, Serial No. 613,686. Mixing Device For Particulate Material.

Henry Fleischer et al. for appellants

Primary Examiner--Norman Morgenstern

Examiner--Kenneth Jaconetty

Before Serota

Chairman

Pellman, Seidleck, Lovell and Steiner

Examiners-in-Chief

Steiner



Examiner-in-Chief

ON BRIEF

This is an appeal from the final rejection of claims 1 through 9. In an amendment submitted on June 24, 1985, claims 2 through 9 were cancelled leaving claim 1. There are no other claims remaining in the application.

Claim 1 reads as follows:

1. An apparatus for mixing flowing developer material, including:

means, defining a chamber, for receiving the flowing developer material therein; and

means for mixing the flowing developer material, said mixing means being stationary and completely submerged in the developer material.

The reference relied upon by the examiner is:

Williams 4,075,977 Feb. 28, 1978

The appealed claims stand rejected under 35 U.S.C. 102(b) as anticipated by Williams. We affirm.

Structurally, the claimed apparatus comprises a chamber and stationary mixing means situated therein. The preambular recitation 'for mixing flowing developer material . . .' and the additional recitation 'completely submerged in the developer material' relate to the identity of the material worked upon by the claimed apparatus and the intended manner of employing the claimed apparatus.

Williams discloses an apparatus satisfying the structural requirements of that claimed; i.e., the disclosed apparatus comprises a chamber and a stationary mixing means situated therein. The disclosed apparatus also enjoys the same utility as that claimed; i.e., for mixing flowing developer material. As the only difference between the claimed invention and the apparatus disclosed by Williams, appellant argues that the mixing means of the claimed apparatus is 'completely submerged in the developer material'; whereas, in Williams' apparatus, the mixing means is depicted 'as only being partially submerged in the developer material' (page 4 of the brief, first full paragraph).

The apparatus disclosed by Williams is employed to mix developer material. Accordingly, the disclosed apparatus satisfies the recitations in claim 1 with respect to the identity of the material intended to be worked upon by the claimed apparatus and the general manner in which the claimed apparatus is intended to be employed. At any rate, a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Rishoi*, 197 F.2d 342, 94 USPQ 71 (CCPA 1952) and *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973), *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971), *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). In this respect, the examiner has factually determined that Williams' mixing device 40 is capable of being totally submerged in the developer material, since gate member 46 is capable of retaining a supply of developer above the top surface of mixing device 40. Appellant has not challenged the examiner's factual determination, which determination appears to be based upon sound technical reasoning.

\*2 In *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974), it was held that a recitation of intended use in a claim directed to a composition does not impose any limitations which differentiates the claimed composition from those which are known in the art. By analogy, the apparatus disclosed by Williams does not undergo a metamorphosis to a new apparatus merely by affixing instructions thereto indicating that a sufficient amount of developer material may be poured into the apparatus to completely submerge the stationary mixing means.

Based upon the foregoing, we agree with the examiner's position that the recitation 'completely submerged in the developer material' does not impose any structural limitations upon the claimed apparatus which differentiates it from that disclosed by Williams. We, therefore, agree with the examiner's determination that Williams' apparatus anticipates that claimed within the meaning of 35 U.S.C. 102(b).

AFFIRMED

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